THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUNG-JOU CHEN
and REBECCA L. DILNIK

Appeal No. 1999-0710
Application 08/716,875

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-20, all the claims currently pending in the application. An amendment filed subsequent to the final

rejection has not been entered. See the advisory letter mailed July 29, 1998 (Paper No. 14).

Appellants' invention pertains to disposable absorbent articles such as diapers, sanitary napkins and the like having a cellulosic transfer layer positioned adjacent to a primary absorbent. Claim 1, a copy of which can be found in an appendix to appellants' main brief, is representative of the appealed subject matter.

The following reference is relied upon by the examiner in support of a rejection under 35 U.S.C. § 102(b):

Lemay et al. (Lemay) 5,374,260 Dec. 20, 1994

Claims 7, 8, 18 and 19 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant[s] regard[] as the invention" (answer, page 3).

Claims 1-6, 9-17 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lemay.

The rejections are explained in the examiner's answer (Paper No. 17).

The opposing viewpoints of appellants are set forth in the main and reply briefs (Paper Nos. 16 and 21).

The 35 U.S.C. § 112, second paragraph, rejection

The examiner's rationale starts with the premise that in order for a claim to pass muster under the second paragraph of 35 U.S.C. § 112, "one of ordinary skill in the art must be able to determine with absolute certainty whether every particular article necessarily falls within the scope of that claim or outside the scope of that claim" (answer, pages 3-4; underlining in original). The examiner notes that the claims in question define the invention in terms of the "mean free path" and "bovine blood absorbency rate" of the transfer layer.[1] According to the examiner,

> [s]ince a myriad of testing rooms conditions, material(s) age, testing location, and the like

[1]Actually, the term "mean free path" is found in the base claims from which claims 7, 8, 18 and 19 depend.

> cause changes in the results of the various tests [used to determine the claimed transfer layer characteristics][2] . . . it is an absolute certainty that at least one article will fall within the scope of the claims given a first set of conditions and outside the scope of the claims given a second set of conditions. [Answer, page 4.]

Thus, the examiner concludes that claims 7, 8, 18 and 19 are indefinite.[3]

There is no requirement that patent claims define the invention with mathematical precision. Rather, if the claims, when read in light of the specification, reasonably apprise those skilled in the art of both the utilization and the scope of the invention, and if the language is as precise as the subject matter permits, the statute demands no more. *Miles Labs., Inc. v. Shandon, Inc.,* 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993); *Hybritech, Inc. v. Monoclonal*

---

[2]Appellants' specification sets forth on pages 7-8 a detailed explanation of how the ordinarily skilled artisan would go about determining the "mean free path" of a layer of material, and on page 6 a detailed explanation of how the ordinarily skilled artisan would go about determining the "bovine blood absorbency rate" of a layer of material.

[3]We note in passing that appealed claims 13 and 20 also define the invention in terms of the same "mean free path" and "bovine blood absorbency rate" characteristics found by the examiner to be indefinite, yet these claims have not been included in this ground of rejection.

Antibodies, Inc., 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986), *cert. denied,* 480 U.S. 947 (1987); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). In the present case, we think the detailed explanation in appellants' specification on pages 6-8 of how the "mean free path" and "bovine blood absorbency rate" of a layer of material are determined are such that those skilled in the art would be reasonably apprised of the metes and bounds of the claims. Accordingly, the examiner's rejection under 35 U.S.C. § 112, second paragraph, will not be sustained.

The 35 U.S.C. § 102(b) rejection

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Each of the independent claims on appeal recites that the transfer layer comprises structural elements defining a mean free path within the range of 50 microns to about 200 microns,

the mean free path being defined as an average of edge-to-edge, uninterrupted distances between all pairs of said structural elements. The examiner concedes that the Lemay reference does not expressly discuss the mean free path of the transfer layer. Nevertheless, the examiner has taken the position that this claim requirement is an inherent characteristic of Lemay's transfer layer (e.g., element 20 in Figure 2) because, according to the examiner, there does not *seem* to be any difference in the methods used to make the transfer layer of Lemay's and appellants' articles, and because Lemay's transfer layer *appears* to have edge-to-edge, uninterrupted distances between all pairs of structural elements within the claimed range (answer, page 6).

The examiner's position on inherency is fatally flawed because there is nothing on the face of the Lemay disclosure which would reasonably lead to the conclusion that the required mean free path range is an inherent characteristic of Lemay's transfer layer, and because the examiner has failed to advance any factual basis or cogent line of reasoning to show that this would be the case. Inherency may not be established by probabilities or possibilities. *In re Oelrich*, 666 F.2d

578, 581, 212 USPQ 323, 326 (CCPA 1981). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* Here, the examiner's position on inherency is based on sheer speculation. As such, the standing anticipation rejection of claims 1-6, 9-17 and 20 cannot be sustained.

Summary

The examiner's rejections under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(b) are reversed.

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED

Irwin Charles Cohen Administrative Patent Judge	)	
Charles E. Frankfort Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Lawrence J. Staab Administrative Patent Judge	)	

tdl

Jerry F. Janssen
Wilhelm Law Service, S.C.
100 W. Lawrence
Third Floor
Appleton, WI 54911